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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,765	03/27/2001	Shuichi Yamaguchi	448563/0191	2415

7590

08/22/2002

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EXAMINER

NGUYEN, JUDY

ART UNIT PAPER NUMBER

2861

DATE MAILED: 08/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,765

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Judy Nguyen

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/24/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 5-10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are directed to a method of manufacturing an ink cartridge which is distinct from the originally claimed method of refilling an ink bag.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-10 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Merrill (US 5,900,895).

Merrill discloses all features of the claimed invention:

- removing the ink bag (column 12; lines 37+) from the ink jet recorder
- positioning the ink bag (Figure 12; column 12, lines 55+)
- inserting an ink needle (200) into a second opening (28) that is different than the first opening (52; see Figure 10), said second opening comprising an ink supply port selectively engageable with an ink jet recorder
- charging the ink bag only through the second opening (28) with a specified quantity of ink
- discharging ink from the ink bag and charging the ink bag both through the port (column 13, line 46 – column 14, line 4)
- with respect to the recitation that the ink needle is inserted into the interior of the flexible bag portion as recited in claim 3 and the second opening is located linearly opposite the first opening as recited in claim 4, these structural limitations do not entitled to patentable weight in the method claims since they do not affect the method in a manipulative sense. Ex parte Pfeiffer, 135 USPQ 31 (1961). It is noted that the steps of removing the ink bag, positioning the ink bag, inserting an ink needle into a second opening, and charging the ink bag through the second opening are essentially all the claims call for by way of method. These are shown to be old by Merrill. The particular structure of the needle being inserted into the interior of the flexible bag portion or the first opening and its usage for

initial filling does not affect the required steps and therefore, does not further limit the method.

Response to Arguments

4. Applicant's arguments have been considered but they are not persuasive. With respect to claim 2, applicant argues that the outlet is not used in both modes during refilling. However, there is no recitation that requires the discharge and charge modes be happened during the refill mode. The examiner noted that applicant discharge mode happened during the emptying of the bag as opposed to during the refilling. Applicant further argues that there is no teaching of discharging the reservoir prior to refilling. However, there is no such limitation recited in the claim. Although the claim recites the steps of discharging and charging, there is no recitation that requires one step being performed before the other.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (703) 305-7062. The examiner can normally be reached on Monday - Friday.



Judy Nguyen
Primary Examiner
August 19, 2002